

Appln. No. 10/826,722
Amendment dated March 27, 2009
Reply to Office Action mailed January 6, 2009

REMARKS

Reconsideration is respectfully requested.

Status of Claims

Claims 4, 20 and 36 have been cancelled.

No claims have been withdrawn.

No claims have been added.

Therefore, claims 1 through 3, 5 through 19, 21 through 35, and 37 through 51 are pending in this application.

Prematurity of finality of rejection in Office Action

It is submitted that the finality of the rejections in the Office Action, particularly the finality of the rejection of claims 49 and 50, is premature as a prima facie case for rejection was not set forth in any previous Office Action. As noted in the previously-submitted response (dated October 15, 2008) to the Office Action mailed July 18, 2008, it was pointed out that the July 18 Office Action did not include any explanation of the basis for rejecting claims 49 and 50, and therefore the burden to rebut the (apparent) rejection of claims 49 and 50 had not shifted.

The pending Office Action mailed January 6, 2009 is marked as being a final Office Action, and includes a basis of rejecting claims 49 and 50 that was not previously presented by the Patent Office in any previous Office Action. MPEP §706.07(a) states that (emphasis added):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Claims 49 and 50 were added prior to the Office Action of July 18, 2008, and were not amended in the response filed October 15, 2008, so therefore

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the newly presented basis for rejecting claims 49 and 50 in the pending Office Action were not "necessitated by applicant's amendment of the claims". Furthermore, the pending Office Action provides no line of reasoning why a basis for rejecting claims 49 and 50 was not or could not have been presented prior to the "final" rejection in the Office Action.

As applicant was not provided with an opportunity prior to the pending Office Action to consider and address a basis of rejecting claims 49 and 50, it is submitted that the "finality" of the rejections in the Office Action is premature, and withdrawal of the finality is respectfully requested.

Further, entry of the above amendments is courteously requested in order to comply with the requirements as to form in the §112 rejection addressed below. MPEP §714.12 states that "amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b)".

Paragraphs 3 through 5 of the Office Action

Claims 1 through 3, 5 through 19, 21 through 35, and 37 through 50 have been rejected under 35 USC 112 (second paragraph) as being indefinite.

The use of the words "beyond" and "may" in claims 1, 16, 17, 32, 33, and 48 has been objected to as being indefinite. While it is believed that the use of these words in the claims is not indefinite and would be understood by one of ordinary skill in the art, in order to facilitate prosecution and remove any doubt, the clause "determining an expiration date *beyond* which a user *may* no longer use said fee-based software residing on the computer system" (emphasis added) has been amended to recite "determining an expiration date *after* which a user *is* no longer *able*

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to use said fee-based software residing on the computer system *due to expiration of a license for use of the fee-based software*" (or similar language). This language is supported in the specification, such as, for example, on page 3, lines 16 et seq.

Withdrawal of the 35 USC 112 (second paragraph) rejection is therefore respectfully requested.

Paragraphs 6 through 7 and 5 of the Office Action

Claims 1 - 3, 5 - 19, 21 - 35 and 37 - 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al. (U.S. Patent Application Publication No. 2003/0033601) ("Sakata") in view of Cheng et al. (U.S. Patent No. 6,763,403) ("Cheng"). This rejection is respectfully traversed.

Claims 1, 16, 17, 32, 33 and 48

Amended claim 1 recites, in part, "determining an expiration date after which a user is no longer able to use said fee-based software residing on the computer system due to expiration of a license for use of the fee-based software" and "offering the user alternative software to the fee-based software based on the expiration date of the fee-based software." Claims 16, 17, 32, 33 and 48 include similar but not identical requirements.

The Office Action alleges that Sakata discloses a method for offering alternative software, comprising: determining an expiration date for software residing on the computer system (e.g. Fig. 2, device 67 "expiration date checking device" and related text); and offering the user alternative software to the fee-based software based on the expiration date of the fee-based software (paragraph [0013] "... software is offered to the user by rental or lease agreement ..." and paragraph [0014] "... software is replaced with new software ...").

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In response to an argument that "checking expiration dates of functions of a broadcast reception terminal" cannot be equated to "determining an expiration date after which a user is no longer able to use said fee-based software residing on the computer system due to expiration of a license for use of the fee-based software" as required by the language of the claims. It is stated in the Response to Arguments section of the current Office Action that:

The Applicant argued that "with respect to paragraph [0012], it is clear that the 'outdated' software still functions (i.e., is not expired), but merely prevents the user from being provided with a 'new service.'" Thus, it is respectfully submitted that paragraph [0012] also does not contain a teaching or suggestion with respect to determining an expiration date beyond which a user may no longer use fee-based software residing on a computer system." (page 3).

In response to the above argument, the examiner would like to reiterate that prior art of record, Sakata does disclose determining an expiration date of fee-based software. Even if arguably outdated software still functions, it is respectfully submitted that Sakata discloses expiration date referring to software becoming inoperative as evidenced in the following paragraphs:

The Office Action then includes paragraphs {0021}, [0028], [0029], [0102], and [0181]. Paragraph [0021] states:

[0021] Alternatively, in this specification, the term "an expiration date" is used as a term meaning not only a time limit with respect to time but also a threshold value with respect to the number of times, namely, the number of times of access or effectiveness unless otherwise specified.

However, it is submitted that nothing here would lead one of ordinary skill in the art to the requirements of claim 1 as amended, and could arguably lead one away from the claim requirements as it discusses "an expiration date" as being something that is triggered by a number of time that something is done, which would make the determination of an expiration date (prior to the actual time that the number of accesses is reached and the function expires) difficult if not impossible to determine.

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Paragraph [0028] of Sakata states:

[0028] Therefore, by setting the expiration date for each function of the terminal, it is possible to make the user reconfirm the expiration date in the processing that the function, of which expiration date has expired, sequentially becomes inoperative, so that it is possible to motivate the user to renew the expiration date. Alternatively, it is possible to secure a communication opportunity for access from the terminal side to the server side as a part of the expiration date management, so that it becomes possible for the server to collect the data from the terminal and to transfer the necessary software to the terminal.

Again, it is submitted that "setting the expiration date for each function of [a] terminal" does not disclose to one of ordinary skill in the art "an expiration date after which a user is no longer able to use said fee-based software residing on the computer system due to expiration of a license for use of the fee-based software". Sakata discusses the expiration of a terminal function, and says nothing about any license expiration for fee-based software.

Looking next to paragraph [0029] of Sakata, it states that:

[0029] Additionally, if the function is merely made inoperative when the expiration date thereof expires, an error such that the function is inoperative is communicated to the user when the user attempts to use the inoperative function, so that the user is forced into selecting another function. According to the present invention, in order to solve this problem, it can be referred as a parameter whether or not a content or an application is within the expiration date period and the inoperative function or the inoperative content is not displayed on a menu screen, so that the user is not able to use the function or content.

This portion of the Sakata patent application publication discusses how the inability of the user to access one function simply forces the user to use another function of the terminal, but nothing here mentions or suggests that the user "is no longer able to use [] *fee-based software* residing on the computer system due to *expiration of a license* for use of the fee-based software" as required by the claim language.

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Further, paragraph [0102] of Sakata states:

[0102] Therefore, the terminal has an opportunity to communicate with the expiration date renewal server every regular period. As a result, it becomes possible for the expiration date renewal server to collect the terminal information necessary for the maintenance to download software for a new service and to renew the portal screen at the terminal side including the guide information to the user in this opportunity.

It is submitted that this portion of the Sakata patent application discusses downloading "software for a new service" which suggests that the software must be replaced at the expiration date, and not merely that the software is not longer of use by the user "due to *expiration of a license* for use of the fee-based software" as required by the claim language. If the software need to be replaced, this would not suggest to one of ordinary skill in the art that *a license* for use of fee-based software has expired", as no mention of a license or a fee is made.

Finally, paragraph [0181] of Sakata states:

[0181] Alternatively, as a part of the monitoring of the expiration date, it is possible to secure a communication opportunity of making a call from a terminal side to a server side, so that it becomes possible that the server collects the data of the terminal by the use of this opportunity and the necessary software is transferred from the server to the terminal. As a result, it is possible to offer a better service to the terminal.

Again, there is nothing here that states or suggests that the software is no longer usable because of the expiration of a license for the fee-based software. Furthermore, the discussion of "better software" does not disclose to one of ordinary skill in the art an "offer of software [] made by a second software vendor different from the first software vendor" as the "better software" could merely be the same software from the same software vendor but upgraded in some aspect. In fact, it is submitted that one of ordinary skill in the art, considering these statements in Sakata,

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would be more likely to understand that the "better software" is from the same source or vendor, and not a different source of vendor.

Further, the Sakata reference, with respect to Fig. 2, indicates that expiration dates are set for individual functions (e.g., activating a remote controller, switching channels, setting a size of a display screen, turning on/off a power supply) of a broadcast reception terminal 60 (paragraph [0073]). Paragraph [0012] is unrelated to Fig. 2 and the description thereof, and describes a problem with providing a new service to a user of an information-based consumer electronic device.

With respect to the statement in the Office Action that "the software expires or becomes disabled when the function of the software expires," the "expiration date checking device" of Fig. 2 of Sakata relates to individual functions of the broadcast reception terminal that are individually controlled by a function activation device. To the extent that the function activation device is implemented with software, it is respectfully submitted that such function of the software would necessarily continue even after any of the individual functions of the broadcast reception terminal expire. The continued function of the software is required so that the function activation device can later re-enable those individual functions of the broadcast reception terminal (paragraph [0074]). Thus, as asserted in responses to previous Office Actions, in the context of Fig. 2 and the related text of Sakata, it is the functions of the broadcast reception terminal that expire, and not the software that implements them.

Furthermore, with respect to paragraph [0012], it is clear that the "outdated" software still functions (i.e., is not expired), but merely prevents the user from being provided with a "new service." Thus, it is respectfully submitted that paragraph [0012] also does not contain a teaching or suggestion with respect to determining an expiration date

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beyond which a user may no longer use fee-based software residing on a computer system.

With respect to the claim requirement of "offering the user alternative software to the fee-based software based on the expiration date of the fee-based software", in response to an argument that "offering a set top box having software is not the same as offering alternative software," it is stated in the Response to Arguments section of the current Office Action that the argument is not persuasive because Sakata teaches that: 1) "a set top box (STB) or the like with a short lifetime of software is offered to the user by a rental or lease agreement (paragraph [0013]);" and 2) "... necessary software (alternative software) is transferred from a server to terminal to offer a better service to the terminal ... (paragraph [0181])." It is indicated in the Office Action that the word "alternative" is "broadly interpreted as 'choice, another version, more possibilities, etc.'."

With respect to the first point, paragraph [0013] only discloses offering a set top box, which happens to incorporate software, to a user. Clearly, it is the set top box that is the subject of the rental or lease agreement, and not the software itself. It is respectfully submitted that, even reading the word "alternative" broadly, that paragraph [0013] does not contain a teaching or suggestion that the set top box having software is offered an "alternative" to anything, much less alternative software to the fee-based software as recited in amended claim 1.

With respect to the second point, it is respectfully submitted that "transferring necessary software from a server to a terminal to offer a better service to the terminal" is also not the same thing as "offering alternative software to fee-based software based on the expiration date of the fee-based software" because, *inter alia*, the act of "transferring necessary software" is not the same as the act of "offering alternative

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software." There is no element of an "offer" in the act of "transferring," and the "transferring" is not performed based on an "expiration date" beyond which a user may no longer use the fee-based software.

Further, in response to arguments that "replacing" is not the same as the act of "offering an alternative" and that "outdated software" is not the same as "expired software," it is stated in the Response to Arguments section of the Office Action that: 1) "It is clear that by offering the software to a user, the reason is to replace the existing software;" and 2) "Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references."

With respect to the first point, it is respectfully submitted that claim 1 does not recite a "reason" with respect to the step of offering a user alternative software, and that even if the reason is as alleged, that Sakata does not contain a teaching of "offering a user alternative software to the fee-based software based on the expiration date of the fee-based software," as recited because neither "replacing outdated software" or "transferring necessary software," contain an element of an "offer." Sakata is concerned with updating existing software, and is not directed at a "method of offering alternative software" as recited in amended claim 1.

With respect to the second point, extensive discussion was presented in the response to the previous Office Action for the arguments in question. It is respectfully submitted that the arguments that the claim terms are different and distinguishable from the teaching of the reference comply with the requirement of pointing out how the language of the claims distinguishes them from the references. As discussed above, Sakata discloses that the functions of the set top box expire, and not the

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software. Sakata observes that "information-based consumer electronic devices tend to have software with a shorter lifetime than that of the hardware," and "[t]herefore, after a passage of time, even if the hardware is in good condition, the user cannot be provided with a new service since the software is outdated." (paragraph [0012]) In this regard, it is clear that the "outdated" software still functions but merely prevents the user from being provided with "a new service." This is in contrast to "expired" software which, as recited in the claim, may no longer be used. Thus, in the context of the teachings of the Sakata reference, "replacing outdated software" and "transferring necessary software to offer better service" are clearly different than "offering alternative software to fee-based software based on an expiration date of fee-based software," as recited in claim 1.

Claims 2, 3, 5 - 15, 49 and 50:

Claims 2, 3, 5 - 15, 49 and 50 depend from independent claim 1 and are allowable for at least the reasons provided in support of the allowability of the independent claim 1. Additionally, many of the dependent claims are separately patentable as discussed below.

With respect to the separate patentability of dependent claim 2, claim 2 recites "transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, wherein the software was not authored by the software vendor and is detected by a monitoring program.

It is suggested in the Office Action that the Sakata reference discloses transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, in paragraph [0169].

Paragraph [0169] describes a means for obtaining the current date and transmitting this date to a security module. It is respectfully that the

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Sakata reference does not teach or suggest transmitting a message to a software vendor at predetermined time intervals prior to an expiration date, as recited in claim 2. Thus, claim 2, as well as claims 18 and 34 which contain equivalent limitations, are separately patentable over the combination of the Sakata and Cheng references.

Turning now to dependent claim 5, which recites after the offering step, providing the alternative software to the user in response to receiving an affirmative response from the user, it is suggested in the Office Action that paragraph [0099] of the Sakata reference discloses the method of claim 5. However, paragraph [0099] of the Sakata reference discloses a log transmitting device that transmits data of a program which has been viewed and recorded data, such as a response to a questionnaire which the user has filled out, to the expiration date renewal server.

It is respectfully submitted that "transmitting a response to a questionnaire which a user has filled out to a server" cannot be equated to "providing alternative software to a user in response to receiving an affirmative response from a user," as recited in claim 5.

Claim 16:

Independent claim 16 recites "wherein the fee-based software is provided by a first software vendor, and wherein the offer of software is made by a second software vendor different from the first software vendor."

It is admitted in the Office Action that Sakata is "silent about the offer of software is made by a second software vendor different from the first software vendor." It is then stated in the Office Action that "it would have been obvious ... to take the suggestions of Sakata ... to include providing a fee-based software by a second software vendor different from the first software vendor in order to sell or market another

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version of the pre-installed software by a second software vendor.”
However, no citation is made to a prior art reference that contains a teaching of the admittedly missing element.

As noted in the Office Action, *KSR Int'l v. Teleflex Inc.* states that “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007). Thus, it must be established that the elements being combined exist in the prior art. It is respectfully submitted that the admittedly missing element from Sakata has not been established to exist in the prior art, by citation or otherwise, and that the conclusory statement that it would have been obvious to include such an element is insufficient to establish a *prima facie* case of unpatentability of the claim.

Therefore, claim 16 is believed to be allowable for at least the reasons provided above.

Claims 18, 19 and 21 – 31:

Claims 18, 19 and 21 – 31 have been rejected as being the system version of method claims 2, 3 and 5 – 15, respectively, and for the same reasons provided with respect to claims 2, 3 and 5 – 15.

However, claims 18, 19 and 21 – 31 depend from independent claim 17, which differs from the scope of claim 1. Thus, 18, 19 and 21 – 31 are not just the “system version” of method claims 2, 3, and 5 – 15. Therefore, for at least the reasons set forth above with respect to claim 17, it is respectfully submitted that a *prima facie* case of unpatentability of the claim has not been established for claims 18, 19 and 21 – 31. Further, it is respectfully submitted that claims 18, 19 and 21 – 31 are allowable for at least the reasons provided in support of the allowability of claim 17.

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Claim 49:

Claim 49 requires "wherein the fee-based software is provided by a first software vendor, and the alternative software is provided by a second software vendor, the second software vendor being different from the first software vendor".

It is contended in the portion of the rejection specifically addressing claim 49 that:

As per claim 49, Sakata of Sakata substantially disclosed the invention as claimed above. However, Sakata was silent about wherein the fee-based software is provided by a first software vendor, and the alternative software is provided by a second software vendor, the second software vendor being different from the first software vendor. Nevertheless, Sakata discloses wherein the fee-based software is provided by a first software vendor (paragraph [0014]'... software is replaced with new software ... provide the updated service..."). Thus it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the suggestions of Sakata related to making an offer by a software vendor to include providing a fee-based software by a second software vendor different from the first software vendor in order to sell or market another version of the pre-installed software by a second software vendor.

However, contrary to what is asserted in the portion of the rejection set forth above, it is submitted that merely because it is believed that the software providing the functions of Sakata are contended to be provided by a first software vendor that it would have been obvious "to include providing a fee-based software by a second software vendor... in order to sell or market another version of the pre-installed software by a second software vendor" as asserted in the line of argument of the rejection. First of all, a search of the text of the Sakata patent application does not reveal even a single mention of any "version" of software, or any mention of the word "market" or of the word "sell". It is therefore submitted that the motivation set forth in the rejection is foreign to the Sakata disclosure, as there is nothing in Sakata that supports an inference that

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the stated motivation is a "suggestion of Sakata" as contended in the rejection.

For the reasons set forth above, withdrawal of the §103 rejections of claims 1 through 3, 5 through 19, 21 through 35, and 37 through 51 is respectfully requested.

Respectfully submitted,

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By



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